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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 09/657,041  | 09/05/2000  | Leonard Pinchuk      | BSI-430US8                    | 9622             |
| 23122   | 7590        | 01/18/2007           |                               |                  |
| RATNERPRESTIA<br>P O BOX 980<br>VALLEY FORGE, PA 19482-0980 |             |                      | EXAMINER<br>THALER, MICHAEL H |                  |
|   |             |                      | ART UNIT<br>3731              | PAPER NUMBER     |
| SHORTENED STATUTORY PERIOD OF RESPONSE                      |             | MAIL DATE            | DELIVERY MODE                 |                  |
| 3 MONTHS  |             | 01/18/2007           | PAPER                         |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/657,041

Applicant(s)

PINCHUK ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 40-58 is/are pending in the application.
- 4a) Of the above claim(s) 43-58 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-30 is/are allowed.
- 6) ☒ Claim(s) 40-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/19/04, 8/9/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

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Newly submitted claims 43-58 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 43-58 (invention I) are drawn to the subcombination of a branched endoluminal support device. The claims originally presented (invention II) are drawn to the combination of a trunk component and a separate leg component.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because combination claim 1 does not include the particular feature that the support portion includes an isthmus as recited in claim 43. The subcombination has separate utility. For example, it could be used without the separate leg component recited in claim 1.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 43-58 are withdrawn from

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consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The indicated allowability of claims 40-42 is withdrawn in view of the newly discovered reference(s) to Martin (5,575,817). Rejections based on the newly cited reference(s) follow.

Claims 40-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Martin (5,575,817). Martin discloses a multi-component bifurcating expandable supportive graft comprising trunk component 7 surrounding a trunk liner 3, the trunk liner 3 having a generally cylindrical body portion 6 and two leg portions 4, 5, wherein the generally cylindrical body portion of the liner 3 and portions of the leg portions 4, 5 (i.e. the radially outward portion of each leg portion 4, 5) abut the trunk component 7 (Note that the trunk component 7, i.e. the mesh support, covers substantially the entire trunk liner 3, i.e. the graft including its leg portions 4, 5 as indicated in col. 2, lines 37-42. Thus, the radially outward portion of trunk liner 3, i.e. the portion of trunk liner 3 which includes its outer surface, abuts the inner surface of trunk component 7 where the trunk liner 3 and trunk component 7 are bonded together.), and portions of the leg portions not abutting the trunk component (i.e. the radially inward portion of each leg portion 4, 5) abut one another and are secured to one another

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(where the leg portions 4, 5 meet at their tops and thus abut each other as shown in figure 1 and where they are secured to one another due to their unitary connection with each other), and a generally cylindrical supportive leg component 2 which is telescopically positioned with respect to one of the leg portions 6 of the liner (col. 3, lines 29-34). As to claim 42, note col. 2, lines 39 and col. 3, lines 23-26 of Martin.

Claims 1-30 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571) 272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

mht



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731